

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of : Customer Number: 46320
: :
Ronald DOYLE et al. : Confirmation Number: 1867
: :
Application No.: 10/663,509 : Group Art Unit: 3689
: :
Filed: September 16, 2003 : Examiner: D. Antonienko
: :
For: ELECTRONIC RECEIPT MANAGEMENT

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated January 6, 2010.

The Examiner's response to Appellants' arguments submitted in the Appeal Brief of September 28, 2009, raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellants rely upon the arguments presented in the Appeal Brief of September 28, 2009, and the arguments set forth below.

REMARKS

Appellants have compared the statement of the rejection found on pages 3-7 of the
Examiner's Answer with the statement of the rejection found on pages 4-9 of the Third Office
Answer. Upon making this comparison, Appellants have been unable to discover any substantial
differences between the respective statements of the rejection. As such, Appellants proceed on
the basis that the Examiner's sole response to Appellants' Appeal Brief is found on pages 8-16 of
the Examiner's Answer in the section entitled "Response to Argument."

Referring to the first full paragraph on page 8 of the Examiner's Answer, the Examiner said the following.

As to Appellant's remarks (page 9 of Appeal Brief) reproduced from the First Response, Appellant concedes that Pitroda teaches electronically storing transaction receipts. However, Appellant then selectively cites that Pitroda discloses that such transactions can be downloaded to a PC or central computer. Appellant further remarks *with the exception of discussing that these transactions can later be analyzed, Pitroda discusses little else with regard to the receipts*. Examiner notes, that a prior art reference discloses more than the instant invention does not negate the fact that the particular limitations are indeed disclosed. Therefore, Pitroda as a prior art reference cannot be dismissed. (emphasis in original)

The Examiner's response to Appellants' arguments reflects a misunderstanding, by the Examiner, as to what Appellants' have actually argued. Claim 1 recites several limitations that involve "store receipt data." Appellants argued that Pitroda discusses little with regard to receipts and the Examiner's cited passages are silent as to many of the limitations being claimed (see page 9, lines 15-19 of the Appeal Brief).

1 The Examiner's response to these arguments is to note that "a prior art reference discloses
2 more than the instant invention does not negate the fact that the particular limitations are indeed
3 disclosed." Appellants' main argument has been and continues to be that Pitroda fails to
4 identically disclose all of the claimed limitations recited in claim 1 and the Examiner's analysis
5 fails to establish that Pitroda teaches these limitations. Appellants' discussion as to what Pitroda
6 actually teaches (see page 9, lines 7-13) provides context to Appellants' other arguments. Thus,
7 Appellants' discussion as to what Pitroda actually teaches supports Appellants' arguments as to
8 what Pitroda does not teach.

9

10

11 Referring to the paragraph spanning pages 8 and 9 of the Examiner's Answer, the
12 Examiner asserted the following:

13 Page 10, line 5 - page 11, line 10 of the Appeal Brief discuss inherency. Appellant has
14 misapprehended what Examiner asserted as inherent. The statement is: **Locating a specific piece**
15 **of information in a database is inherent.** Examiner maintains this statement of inherency. It
16 appears that Appellant has widened the scope of this statement to include "techniques that can be
17 used to obtain information from a database" (page 11, line 7 of Appeal Brief). Examiner clarifies
18 that this statement of inherency does not include any techniques for locating the specific piece of
19 information, but simply that a database stores information for the purpose of accessing said
20 information. In other words, as noted preceding the statement of inherency in the Second Office
21 Action: **A database by definition is a collection of data organized in such a way that**
22 **facilitates access or retrieval of the data, among other things.** This is what a database is and its
23 function. Information or data is not stored in a database must for the sake of storing information
24 without the capability of accessing or retrieving the information. But there are options on how to
25 set up a database. Therefore, Examiner did not include in the statement of inherency any
26 techniques of retrieving data. For example, a filing cabinet is used to store files. This is the
27 function of a filing cabinet. How the filing cabinet is organized in order to facilitate retrieval is
28 varied. Two common ways are that it can be organized alphabetically or numerically. (emphasis
29 in original)

30

31 Appellants appreciate that the Examiner has clarified the Examiner's previous inherency
32 statement, which is reproduced on page 10, lines 7-15 of the Appeal Brief, and a portion of
33 which is reproduced below:

34 Regarding Claims 1, 9, and 13, Applicant argues that Pitroda does not teach (i) *locating a specific*
35 *electronic receipt stored within the data store which corresponds to an identifier provided by the*

1 *individual one of the multiple disparate vendors.* Examiner respectfully disagrees. ... Therefore,
2 Examiner maintains that Pitroda does anticipate this limitation. (emphasis in original)
3

4 The Examiner is now asserting that instead of Pitroda inherently teaching the entire
5 italicized language in the above reproduced passage, that Pitroda inherently teaches "[l]ocating a
6 specific piece of information in a database." However, Appellants have not merely claimed
7 locating a specific piece of information in a database.
8

9

10 Regarding the Examiner's discussion, in the paragraph spanning pages 9 and 10 of the
11 Examiner's offer made on July 22, 2009, "to provide a Supplemental Action with further
12 explanation," Appellants note that at the time this offer was made, Appellants only had 6 days to
13 respond to the pending Final Office Action. Given that Pitroda does not anticipate the claimed
14 invention and Appellants could be placed in a tenuous position of waiting for a promised
15 Supplemental Action while the clock was ticking down on Appellants' time to respond,
16 Appellants declined.

17

18

19 After 3 pages of dancing around the issues at hand, the Examiner analysis begins in
20 earnest in the first full paragraph on page 11 and in the paragraph spanning pages 11 and 12 of
21 the Examiner's Answer. Referring to the first paragraph, the Examiner asserted the following:

22 First, Pitroda teaches *corresponding to each card, a transaction memory area 410 is provided to*
23 *store all transaction receipts in electronic form to eliminate or reduce paper receipts* (column 12,
24 lines 21-24).... *The UET card software also includes an operating system 412, memory*
25 *management 413, database management 414, display formats and associated management 415,*
26 *analysis algorithms and procedures 416* (column 12, lines 27-30). Examiner notes that the UET
27 card has an operating system. A processor requires an operating system. Nonetheless, column 11,
28 lines 37-38 explicitly disclose that the UET card includes a microcontroller. Figure 3 discloses
29 same. (emphasis in original)

1 In short, the Examiner alleges that each card includes a memory (to store transaction receipts), a
2 processor, and an operating system. These points, however, are not in dispute. Thus, the
3 Examiner's true analysis boils down to the next paragraph.
4
5

6 Referring to the second paragraph, the Examiner asserted the following:

7 Second, Pitroda teaches a POS (point of sale, i.e. vendor) database to include one or more POS ID
8 numbers, credit card company numbers, service numbers, and department identifications or sales
9 identifications, or the like (column 12, lines 62-67). As noted above in the inherency discussion,
10 since *a database by definition is a collection of data organized in such a way that facilitates*
11 *access or retrieval of data, among other things, and locating a specific piece of information in a*
12 *database is inherent, that the instant database is indexed or organized by a vendor identifier or a*
13 *transaction identifier does not effectively serve to patentably distinguish the claimed invention*
14 *over the prior art.* Also, that Pitroda does not use the same words as the instant limitation does not
15 effectively serve to patentably distinguish the claimed invention over the prior art. For example,
16 the limitation recites a vendor identifier or a transaction identifier, whereas Pitroda recites POS ID
17 numbers or sales identifications. Therefore, Pitroda teaches *a receipt management processor*
18 *programmed to moderate access to said store receipt data in said storage medium to an individual*
19 *one of said multiple disparate vendors, wherein said storage medium further comprises a*
20 *configuration for indexing said store receipt data according to at least one of a vendor identifier*
21 *and a transaction identifier.* (italics in original, underline added)
22

23 The underlined portion of the above-reproduced passages represents the "meat" of the
24 Examiner's analysis. Specifically, by asserting that "the instant database is indexed or organized
25 by a vendor identifier or a transaction identifier does not effectively serve to patentably
26 distinguish the claimed invention over the prior art," the Examiner is essentially asserting that the
27 Examiner is ignoring any limitations regarding the claimed receipt management processor.
28 Thus, the Examiner has converted "a receipt management processor programmed to moderate
29 access to said store receipt data in said storage medium to an individual one of said multiple
30 disparate vendors, wherein said storage medium further comprises a configuration for indexing
31 said store receipt data according to at least one of a vendor identifier and a transaction identifier"
32 into "a processor programmed to moderate access to data in a storage medium."
33

1 Therefore, the Examiner's analysis is not (nor apparently has been) that Pitroda
2 identically discloses all of the claimed limitations. Instead, the Examiner's analysis involves
3 choosing to ignore many of the claimed limitations, and only after the Examiner has ignored
4 these claimed limitations does the Examiner assert Pitroda identically discloses the claimed
5 invention. The Examiner ignoring these claim limitations is in direct conflict with the case law
6 found within In re Lowry.¹ The Federal Circuit addressed the concept of a data structure within
7 a memory with regard to an obviousness rejection and held the following:

8 In short, Lowry's data structures are physical entities that provide increased efficiency in computer
9 operation. They are not analogous to printed matter. The Board is not at liberty to ignore such
10 limitations.

11
12 Like the data structures of Lowry, which the Federal Circuit describes as "specific
13 electrical or magnetic structural elements in a memory," the claimed receipt processor has a
14 specific structure that differs from the structure of a processor that has not been programmed to
15 "moderate access to said store receipt data in said storage medium to an individual one of said
16 multiple disparate vendors, wherein said storage medium further comprises a configuration for
17 indexing said store receipt data according to at least one of a vendor identifier and a transaction
18 identifier." Additionally, like the data structures of Lowry, which the Federal Circuit describes
19 as "[enabling] powerful nested operations," the claimed programmed receipt processor has been
20 enabled to perform specific operations (e.g., those claimed), which a processor that has not been
21 programmed to perform these operations cannot perform.

22
23 Since the Examiner's anticipation analysis is based upon disregarding certain claim
24 limitations, and since based upon the case law within In re Lowry, the Examiner cannot properly

¹ 33 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

1 ignore these claim limitations, the Examiner has committed reversible error in rejecting claim 1
2 under 35 U.S.C. § 102 for anticipation based upon Pitroda.

3

4

5 On pages 12 and 13 of the Examiner's Answer, the Examiner presented two pages of
6 discussion as to claims 19 and 22. However, referring to pages 13 and 14 of the Appeal Brief,
7 Appellants did not present separate arguments as to claims 19 and 22. Instead, claims 19 and 22
8 stand or fall together with claim 1.

9

10

11 The Examiner's responsive arguments as to claims 9 and 13 is found on pages 14 and 15
12 of the Examiner's Answer. Referring to the last full paragraph on page 14 of the Examiner's
13 Answer, the Examiner asserted the following:

14 As to Appellant's remarks regarding vendor identification numbers (pages 18-19), it appears
15 that Appellant forwards the inventive concept of establishing identification numbers for "Vendor
16 A and Vendor B, both with two stores," in order to be able to ascertain which of the four stores a
17 purchase was made. Pitroda teaches *a transaction memory 410 is provided to store all transaction*
18 *receipts in electronic form to eliminate or reduce paper receipts... database management 414...*
19 *POS ID numbers... sales identifications* (column 12, lines 21-32 and lines 60-67; Figure 2).
20 Examiner asserts that Pitroda teaches keeping transactions separate in order to retrieve the exact
21 receipt being sought. Examiner further asserts that it would be reasonable for one skilled in the art
22 to infer that Pitroda would keep four stores separate in order to be able to retrieve the appropriate
23 receipt. *In considering disclosure of reference patent, it is pertinent to point out not only specific*
24 *teachings of patent but also the reasonable inferences which one skilled in the art would logically*
25 *draw therefrom.* In re Shepard, 138 USPQ 148 (CCPA 1963).

26
27 The Examiner is confusing "reasonable inferences" with hindsight reconstruction. A reasonable
28 inference, for example, is that although a computer is not taught as including a power supply, a
29 power supply is necessary for a computer to operate. Thus, one can reasonably infer that a
30 computer includes a power supply.

31

1 The Examiner's current inference from the applied prior art, however, cherry picks one
2 method (i.e., "keep four stores separate in order to be able to retrieve the appropriate receipt")
3 from a multitude of possible methods of keeping transactions separate. For example, a card
4 could provide each individual receipt with a number based upon the order in which the receipt
5 was received (i.e., 001, 002, 003 ...) or the date and time in which the receipt was received (i.e.,
6 12:25:2010:14:25 or December 25, 2010 at 2:25PM). Thus, the Examiner's alleged "reasonable
7 inference" is more the Examiner attempting to bolster a deficient analysis than making a
8 reasonable inference from the teachings of the applied prior art.

9

10 As admitted by the Examiner and also reproduced on page 18, lines 11-19 of the Appeal
11 Brief, "Pitroda does not explicitly teach locating a specific electronic receipt stored within said
12 data store which corresponds to an identifier provided by said individual one of said multiple
13 disparate vendors." The fact that Pitroda teaches a transaction memory 410 that stores all
14 transactions receipts does not provide one skilled in the art a reasonable inference as to how
15 Pitroda stores those receipts or how those receipts are subsequently retrieved.

16

17

18 Referring to the first full paragraph on page 145 of the Examiner's Answer, the Examiner
19 also asserted the following:

20 As to Appellant's remarks regarding transmitting a receipt to a vendor (pages 20-21), it appears
21 that Appellant forwards the inventive concept of presenting a receipt to a vendor. Examiner notes
22 the well known manual step of presenting a receipt to a vendor as proof of purchase in order to
23 return the purchase. That this manual step is now automated to an electronic transmission does not
24 effectively serve to patentably distinguish the claimed invention over the prior art. *It is not*
25 *'invention' to broadly provide a mechanical or automatic means to replace manual activity which*
26 *has accomplished the same result.* In re Venner, 120 USPQ 192 (CCPA 1958), In re Rundell, 9
27 USPQ 220 (CCPA 1931). (emphasis in original)
28

1 The Examiner's reliance upon In re Venner is misplaced. The result is not the same and a
2 manual activity has not been replaced. Instead, the Examiner has abstracted the result of an
3 electronic receipt being transmitted over a communications to a vendor to the result of handing
4 over a paper receipt. Following the Examiner's analysis, a unique drill using a unique power
5 supply, a unique gearing system, and unique drill bit would be not be an invention because the
6 results (i.e., the creation of a hole) has been accomplished manually with a rock and sharp stick
7 for thousands of years. So long as the result is abstracted to a high enough level, many
8 patentable devices could full under this language.

9

10 Regarding In re Rundell, what the Court stated was "[t]he mere statement that a device is
11 to be operated automatically instead of by hand, without a claim specifying any particular
12 automatic mechanism, is not the statement of an invention." These facts of the present
13 application, however, are not similar to the fact pattern within In re Rundell. Thus, the
14 Examiner's reliance upon In re Rundell is also misplaced.

15

16 Similar to the Examiner's analysis in the rejection under 35 U.S.C. § 102, the Examiner
17 has not attempted to establish that the applied prior art renders obvious all of the claimed
18 limitations. Instead, the Examiner's analysis involves improperly ignoring certain of the claimed
19 limitations and then asserting that the remaining limitations are obvious in view of the applied
20 prior art.

21

For the reasons set forth in the Appeal Brief of September 28, 2009, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. §§ 102, 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: February 26, 2010

Respectfully submitted,

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